REMARKS

This is in response to the Office Action mailed on February 8, 2006, and the references cited therewith.

No claims are amended. Claims 1-14 are now pending in this application.

§101 Rejection of the Claims

Claims 1-14 were rejected under 35 USC § 101 because the subject matter is directed to non-statutory subject matter. This rejection is respectfully traversed at least on the basis that the present claims provide a useful, concrete and tangible result, satisfying the test of State Street bank.

Claims 1-14 describe a series of steps undertaken by a group or team of individuals for making a model that helps to predict decisions that may be made by another individual or group, such as terrorists. The useful, concrete and tangible result of the methods claimed is clearly stated in the detailed description at paragraph [0038]: "The goal is not so much to perfectly predict every attack (although clearly the devastating scenarios need to be responded to), but to identify common vulnerabilities to efficiently utilize resources in protecting such vulnerabilities."

While some of the words used in the claims may relate to abstract concepts, the method itself is about quantifying such concepts, and actually manipulating them in a new and unique way to produce the useful, concrete and tangible result. At its core, every invention may be expressed as an abstract concept. Steering a plane, measuring temperature, etc. Yet, it is the implementations of these ideas and abstract concepts that are patentable.

The present claims recite elements that take concepts, and concretely represent them and calculate based on them to provide valuable information that allows one to efficiently utilize resources in protecting against terrorist attacks. Compare this noble useful, concrete and tangible result with the results produced by State Street – a dollar amount, and AT&T - a data structure that facilitates billing. Apparently a method that modifies abstract concepts related to money is patentable. Money and value are abstract concepts in themselves, yet inventions that quantify them are found patentable. The present application actually may save lives. It would be a

travesty to deny it protection merely because it can be characterized, as perhaps can all other inventions, as mere manipulation of abstract concepts.

The Office Action indicates that "Regardless of whether any of the claims are in the technological arts, none of them is limited to practical applications in the technological arts." While In re Warmerdam and AT&T are cited, the stated requirement that a practical application has to be in the technological arts is not identified in such cases. In fact, In re Lundgren, recently decided by an expanded board of appeals panel in the USPTO has expressly eliminated a technological arts requirement. To now expand the technological arts doctrine to indicate that the practical application has to be in the technological arts is against the holding of In re Lundgren.

Applicant is unsure how the State Street holding as stated in the Office Action produces a useful, concrete and tangible result in the technological arts. The result in State Street is "a final share price momentarily fixed for recording purposes." If a share price is in the technological arts, the creation of a decision making model, and an assessment of the possible decision outcomes with respect to the decision making model would also be within the technological arts. One relates to value of assets, and the claimed invention relates to prediction of decisions, decision outcomes, which allows proper asset management. A real world use of the result.

The presently claimed invention also transforms data representing motivations, creating a decision making model from the motivations and weighting of the motivations. Possible decision outcomes are identified, and the model is used to assess the possible decision outcomes. Thus, decision making is quantified by a group and multiple calculations are used to further quantify decision making to determine possible outcomes. The invention as claimed may sound complex, but that does not make it totally abstract and unpatentable.

Paragraph 7 of the Office Action indicates that Applicant does not specify the associated practical application with the kind of specificity that the Federal Circuit used in State Street. It should be noted that there is no requirement that a claim identify a practical application, only that the result of what is claimed be useful, concrete and tangible. Applicant has indicated above at least one practical application of the claimed invention, and has identified where in the specification such a practical application is discussed.

In Paragraph 9 of the Office Action, "Examiner finds that Applicant manipulated a set of abstract 'motivation' to solve purely algorithmic problems in the abstract (i.e., what kind of motivation is used? Philosophical ideas? Even vague expressions, about which even reasonable persons could differ as to their meaning? Combinations thereof?) Clearly, a claim for manipulation of motivation is provably even more abstract (and thereby less limited in practical application) than pure 'mathematical algorithms' which the Supreme Court has held are per se nonstatutory – in fact, it includes the expression of nonstatutory mathematical algorithms." The claimed invention does deal with the abstract concept of predicting decisions. However, it adds concreteness to the task, but using a group of individuals, who given a potential target, use tools to identify the motivation of the potential attacker, and further using such tools and actual concrete quantifications of the motivation to determine the most likely forms of attacks, or decision outcomes. Thus, it takes an abstract decision making process of an individual and predicts what that individual may decide. Thus, regardless of how abstract the claim may seem, it quantifies abstract concepts and produces a useful, concrete and tangible result that has real world applications.

Paragraph 11 of the Office Action appears to use AT&T as a validation of Warmerdam. However, it should be noted that AT&T tries to distance itself from Warmerdam by including the statement: "Whether one agrees with the court's conclusion on the facts..." It essentially limits Wamerdam to a statement that "mere laws of nature, natural phenomena, and abstract ideas" are not patentable. If the present claims do recite one or more abstract ideas, they also recite elements that provide a useful, concrete and tangible result and are therefore patentable subject matter. Further, any such abstract ideas are not preempted by the claims.

Paragraph 13 of the Office Action indicates that the invention is merely the manipulation of abstract ideas. "The data referred to by Applicant's word "motivation" is simply an abstract construct that does not provide limitations in the claims to the transformation of real world data (such as monetary data or heart rhythm data) by some disclosed process." This statement is respectfully traversed. Real world data is transformed. The potential decisions of a person or group, such as a terrorist regarding targets to attack is determined. Real world data comprising the opinions of a group of experts is transformed into a decision making model and potential outcomes of the decision making are identified. The prediction of likely targets and modes of

attack is clearly real world data, and it allows efficient allocation of resources to prevent such attacks. This is just one example of a use of the methods claimed. It provides a useful, concrete and tangible result, and clearly constitutes patentable subject matter.

§112 Rejection of the Claims

Claims 1-14 were rejected under 35 USC § 112, first paragraph, because current case law (and accordingly, the MPEP) require such a rejection if a § 101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed *how* to practice the *undisclosed* practical application. This rejection is respectfully traversed. Applicant has described at least one practical application, and provided reference to the detailed description where such practical application is taught. Since such a practical application has been identified, the rejection should be withdrawn.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2140 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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Date May 8 2006

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 8th day of May, 2006.

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